Paper No. 34

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KERSTIN JOHANSSON, ROY HANSSON, and ANN SAMUELSSON

Appeal No. 2001-2422
Application No. 08/817,573

HEARD: January 10, 2002

Before FRANKFORT, STAAB, and NASE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 9, which are all of the claims remaining in this application. Claim 10 has been canceled.[1]

[1] Claims 2 and 9 were amended in Paper No. 24, filed July 26, 2000, subsequent to the final rejection. While the examiner has indicated that this amendment has been approved for entry, we note that the amendment has not as of yet been clerically entered. This oversight should be corrected during any further prosecution of the application before the examiner.

Appellants' invention relates to a pants-type sanitary napkin or incontinence guard for women and, more specifically, to such an article having improved fit on users of all sizes. As explained generally on page 2 of the specification, appellants have provided a waist border on the article wherein the border will have greater resistance to stretch in those parts of the border that are located in the side parts than in the remaining parts. This allows those parts of the waist border which have a lower stretch resistance to be stretched first, while those parts which have a greater stretch resistance to only be stretched when necessary. Appellants note that this provides the advantage that fewer models or sizes of the articles need be produced in order to accommodate variations in the body shapes of users while providing a good and snug fit. Independent claim 1 is representative of the subject matter on appeal and a copy of that claim may be found in Appendix A of appellants' brief.

The prior art references of record relied upon by the examiner are:

Pieniak et al. (Pieniak)	4,337,771	Jul. 6, 1982
Jessup '158	5,545,158	Aug. 13, 1996 (filed Jun. 23, 1994)
Kitaoka (Unicharm '147)	JP 04-371147	Dec. 24, 1992
Sasaki et al. (Sasaki) (Unicharm '148)	JP 04-371148	Dec. 24, 1992

Claims 1, 2, 5, 8 and 9 stand rejected under 35 U.S.C. § 102(e) as anticipated by Jessup '158.

Claims 3 and 7 stand rejected under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as being obvious over Jessup '158.

Claim 4 stands rejected under 35 U.S.C. § 103 as being unpatentable over Jessup '158 in view of Pieniak.

Claim 6 stands rejected under 35 U.S.C. § 103 as being unpatentable over Jessup '158 in view of Unicharm '147 and Unicharm '148.[2]

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we refer to the first Office action (Paper No. 5, mailed October 21, 1997), the final rejection (Paper No. 22, mailed January 27, 2000) and the examiner's answer (Paper No. 28, mailed December 19, 2000) for a complete exposition of the examiner's position and to appellants' brief (Paper No. 27, filed September 26, 2000) and reply brief (Paper No. 29, filed February 20, 2001) for the arguments thereagainst.

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[2] While the examiner has urged (answer, page 3) that appellants are "not appealing" certain of the rejections listed in their brief, we note that the Notice of Appeal (Paper No. 25) belies any such conclusion. Although appellants' have indicated on page 6 of their brief that claims 1 through 9 have been grouped together and will thus stand or fall together, this does not mean that any of the rejections set forth in the final rejection are not being appealed. As for the Unicharm references, our understanding of the disclosures of these references is based on a translation of each prepared for the USPTO in November 1997 and of record in the application file.

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Having carefully reviewed the anticipation and obviousness issues raised in this appeal in light of the record before us, we have come to the conclusion that the examiner's rejections of the appealed claims under 35 U.S.C. § 102(e) and 35 U.S.C. § 103 will not be sustained. Our reasoning in support of these determinations follows.

Regarding the examiner's rejection of claims 1, 2, 5, 8 and 9 under 35 U.S.C. § 102(e) based on Jessup '158, the examiner has urged (final rejection, page 2) that the elasticity of the waist border taught in Jessup '158 is correlated to resistance to stretch and thus Jessup '158 inherently teaches the resistance to stretch as claimed. The examiner notes that

> [s]ince jessup [sic, Jessup '158] teaches the central parts of the waist border can have the same elasticity or different elasticity, i.e. greater or lesser elasticity, as compared to the side parts, Jessup teaches that the elasticity of the central parts can be anything. Likewise since there is necessarily a correlation between elasticity and resistance to stretch it follows that the resistance to stretch can also be anything.

However, appellants have argued that the examiner's conclusion that Jessup '158 inherently teaches resistance to stretch as set forth in claim 1 on appeal is based on an incorrect understanding of the basic principles of elongation and resistance to stretch, and that there is no teaching in Jessup '158 to support making any determination regarding the relative resistance to stretch between the various parts of the waist border therein because there is insufficient information provided in Jessup '158 to support any such conclusion. In that regard, appellants note that since Jessup '158 only discloses the elongation of the elastics therein, there is no teaching of stiffness or resistance to stretch of the elastic materials used
therein. The declaration by Ann Samuelsson (Paper No. 21, filed November 12, 1999) supports this argument.

Like appellants, it is our opinion that the examiner's stated position lacks reasonable support in Jessup '158 and is based entirely on speculation and conjecture on the examiner's part. It is well settled that inherency may not be

established by probabilities or possibilities, but must instead be "the natural result flowing from the operation as taught." See In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981). In the present case, the examiner's apparent theory of a direct correlation between the elasticity taught in Jessup '158 and resistance to stretch is unfounded. Moreover, the examiner has in no way established or even reasonably attempted to establish that the disclosure of Jessup '158 when viewed by one of ordinary skill in the art would provide an adequate factual basis to establish that the natural result flowing from following the teachings of that reference would be a sanitary napkin or incontinence guard including an elasticized waist border that has a greater resistance to stretch in the first and second side parts thereof than in the central parts, as required in appellants' claims before us on appeal. Indeed, the examiner's own position (final rejection, page 2) that the elasticity of the center parts in Jessup '158 "can be anything" and, thus, that it follows that the resistance to stretch "can be anything," belies a conclusion that Jessup '158 inherently teaches appellants' specifically claimed subject matter.

Since the examiner has not demonstrated that all the limitations of appellants' independent claim 1 are found in Jessup '158, either expressly or under principles of inherency, it follows that the examiner has not established a *prima facie* case of anticipation, and that the examiner's rejection of claim 1 under 35 U.S.C. § 102(e) relying on Jessup '158 will not be sustained. It follows that the examiner's rejection of dependent claims 2, 5, 8 and 9 under 35 U.S.C. § 102(e) relying on Jessup '158 will also not be sustained.

As for the examiner's rejection of dependent claims 3 and 7 on appeal under 35 U.S.C. § 102(e)/103 based on Jessup '158, for the reasons set forth above, these rejections will not be sustained. Regarding the examiner's rejection of dependent claim 4 over Jessup '158 in view of Pieniak, and the rejection of claim 6 based on Jessup '158 in view of Unicharm '147 and Unicharm '148, we have reviewed the applied secondary references, but find nothing therein which would provide for that which we have found above to be lacking in Jessup '158.

Accordingly, we will not sustain either of the examiner's additional rejections under 35 U.S.C. § 103.

In summary: the decision of the examiner to reject claims 1, 2, 5, 8 and 9 under 35 U.S.C. § 102(e) based on Jessup '158 is reversed, as is the examiner's decision to reject dependent claims 3 and 7 under 35 U.S.C. § 102(e)/103 based on Jessup '158 alone and claims 4 and 6 under 35 U.S.C. § 103 based respectively on Jessup '158 and Pieniak or the two Unicharm references.

REVERSED

CHARLES E. FRANKFORT Administrative Patent Judge	)
LAWRENCE J. STAAB Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
JEFFREY V. NASE Administrative Patent Judge	)

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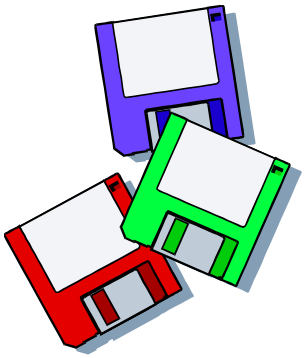

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Appeal No. 2001-2422
Application No. 08/817,573

APJ FRANKFORT

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APJ STAAB

DECISION: REVERSED

Prepared: September 24, 2002

Draft Final

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